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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,387	02/24/2004	Frederico Wagner	WAGN.005A3	6573
20995	7590	09/21/2005		
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			EXAMINER HESS, DANIEL A	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/785,387

Applicant(s)

WAGNER ET AL.

Examiner

Daniel A. Hess

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Period for Reply
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-24 and 56-62 is/are allowed.
- 6) ☒ Claim(s) 1-11, 25-27, 29-31, 33, 34, 36-38, 40-50 and 52-54 is/are rejected.
- 7) ☒ Claim(s) 28, 32, 35, 39, 51 and 55 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/9/05, 12/3/04</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This action is in response to 2/24/2004 initial filing by the applicant.

Information Disclosure Statement

The information disclosure statement filed 4/19/2004 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the applicant has merely included copies of forms 892 and 1449 that were used in a previous case, with timestamps, serial numbers, and/or examiner signatures/initials from the earlier case. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 5, 6, 9-11, 34, 40, 42-44, 47, 48, 52-54 are rejected under 35 U.S.C. 102(e) as being anticipated by Emmott et al. (US 6,425,487).

Re claim 1:

Each claimed limitation below is listed in italics, followed by a discussion the teachings in Emmott et al. that show the claimed limitation:

An information processing apparatus, comprising:

a processor;

Emmott et al. teaches a waste depository (column 1, line 5) which has a control unit (column 2, line 1).

a scanner coupled to the processor, the scanner configured to scan a code on items;

Emmott et al. teaches (column 3, lines 35-45) and RFID scanner reads a code on items.

a network interface coupled to the processor, the network interface configured to transmit and receive information over a network;

Emmott et al. teaches (column 3, lines 60-67):

“As a second process, the control unit 12 also records the product

associated with waste article 20 (in this example a quantity of vegetable oil)

in a "shopping list". The shopping list can be printed out via the printer 16.

Alternatively, the list can be transmitted, via a modem and telephone line or

an electricity line to a grocery store or a supermarket. In such a case, the

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items on the list can be collected together at the store and subsequently delivered to the user's home.”

The modem is a network interface.

a database storing information related to a discard unit's contents, and

The so-called “shopping list” of discarded items (column 3, lines 60-67) amounts to a database.

profile information associated with a user of the discard unit; and

One piece of profile information is the store a user shops at. Since an order is placed (column 3, lines 60-67) by the system, it must have, at least at the time of order, information about a user's desired store.

a remote processing system configured to be coupled to the discard unit via the network, the remote processing system including:

This is that system which is at the receiving end (i.e. at the grocery store or supermarket) which is clearly indicated in Emmott et al. (column 3, lines 60-67).

a first instruction stored in computer readable memory configured to receive at least a portion of the stored information from the database, wherein the received information provides an indication as to when at least a first item is to be replenished;

As is conveyed in Emmott et al., column 3, lines 60-67, a store system operates, in software, to provide data from the list (i.e. stored information in the database) which indicates that it is time to replenish a particular item.

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a second instruction stored in computer readable memory configured to provide at least a portion of the received information to at least a first supplier so that the first supplier can predict inventory needs.

Collection of items at a store and delivery to a user (column 3, lines 60-67) is discussed, clearly indicating that items on a list are collected and delivered to a user's home. This implies that there exist instructions to convey the modem – transmitted information to a supplier.

Re claim 5: The system must, at least on a temporary basis, store a user's preferred store, in order to put in the order for more goods which Emmott et al. discuss.

Re claim 6: The supplier in Emmott et al. is a retail entity.

Re claims 9-11: All of the steps have been discussed above.

Re claim 34: All of the claimed steps are explicit or implied in the discussion re claim 1 above.

Regarding selecting an entity for an order to be placed, at the very least, the user must provide one store for the system to place an order to. The process of entering this store involves obtaining user selection criteria, which indicate at least one store. Note the claim does not require multiple stores to be in communication with the local depository receptacle.

Re claim 40: At least an address is necessary for Emmott et al.'s delivery to a user's home (column 3, line 67). This address is a type of delivery preference.

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Re claim 42: Emmott et al. has a motion sensor in the broad sense that if the RFID is moved into range, it will be picked up.

Re claim 43: See discussion re claim 1, above.

Re claim 44: At least an address is necessary for Emmott et al.'s delivery to a user's home (column 3, line 67). This address is a type of delivery preference.

Re claim 47: The system must, at least on a temporary basis, store a user's preferred store, in order to put in the order for more goods which Emmott et al. discuss.

Re claim 48: The supplier in Emmott et al. is a retail entity.

Re claims 52-54: See discussion re claim 1, 47 and 48 above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2-4, 7, 8, 36, 37, 41, 45, 46, 49, 50 rejected under 35 U.S.C. 103(a) as being unpatentable over Emmott et al. as applied to claim 1, above.

Re claims 2, 3, 4, 7, 8, 41, 45, 46, 49, 50: See discussion re claim 1 above. Also note that Emmott et al. has provisions for order fulfillment.

Lacking in Emmott et al. is a teaching specifically of how the order execution takes place.

However, experience with internet ordering has shown the benefits of convenience to the user for delivery preferences, shipping preferences, order triggering, anonymous ordering, and

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order centers (such as owned by Amazon.com) which aggregate information. The motivation is greater customer satisfaction and efficient and successful delivery.

Re claim 36: In Emmott et al. (column 5, lines 7-13) the user can bypass the ordering process. There are also multiple bin compartments, so the claimed situation *could* take place.

Re claim 37: It is a common practice, especially at Point-Of-Sale locations, that if a code cannot be scanned, it is entered manually.

In view of this practice, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known manual entry of codes as a backup system if automatic scanning fails.

Claims 25-31, 33, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emmott et al. as applied to claim 1, above, in view of Phillippe et al. (US 6,643,624).

Re claim 25, 37: Emmott et al. teaches all of the recited limitations except searching over a computer network for a product match if a match is not found at a store. As for the limitation of a 'presence sensor' that initiates scanning, Emmott et al. teaches (column 3, lines 28-35) radio-frequency ID technology, which operates on a principle of proximity.

Lacking in Emmott et al. is searching over a computer network for a product match if a match is not found at a store.

Phillippe et al. is one example of a system that attempts to locate products across a plurality of different networked vendors.

In view of Phillippe's teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known searching over a

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computer network among a number of vendors to find a product match because if a product cannot be found locally, chances are high it still can be found over the Internet.

Re claim 26: Emmott et al. has a motion sensor in the broad sense that if the RFID is moved into range, it will be picked up.

Re claim 27: It is understood in the art that bar code scanners can be interchanged with RFID in many applications including the present one.

Re claim 29: Emmott et al. has means (column 5, lines 8-13) for a user to manually override the system's scanning process and list compilation process.

Re claims 30 and 31: See discussion re claims 2, 3, 4, 7, 8 above.

Re claim 33: As for a display, a user can edit the shopping list (column 5, line 8), which requires a display. To display price information is common in a networked ordering environment, because this aids a user in deciding if they want to make a particular purchase.

Allowable Subject Matter

Claims 12-24 and 56-62 are allowed.

The prior art of record fails to teach or fairly suggest, in the context of the various other method steps, the grouping of orders and setting of a bid price based on order information which is collectively gathered from information scanned from disposed items.

Claims 28, 32, 35, 39, 51 and 55 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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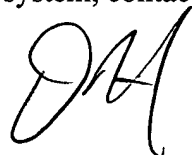
With each of the above claims, the recited limitations of the dependent claim, in the context of all other limitations upon which the claim depends, is neither taught nor suggested in the prior art of record.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A. Hess whose telephone number is (571) 272-2392. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DH
9/13/05

DANIEL STCYR
PRIMARY EXAMINER

